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08/815,556	03/12/97	SULLIVAN	M DLD-2-035-1

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DIANE F. COVELLO, ESQ.
DIVISION PATENT AND TRADEMARK COUNSEL
SPALDING SPORTS WORLDWIDE, INC.
425 MEADOW STREET P.O. BOX 901
CHICOPEE MA 01021-0901

EXAMINER

GRAHAM, M

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 24

Application Number: 08/815,556
Filing Date: 3/12/97
Appellant(s): Sullivan

Richard M. Klein
For Appellant

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed 7/23/98, 10/1/98.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

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A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct. The exhibits filed with the 7/23/98 brief and the supplemental 10/1/98 brief have not been entered. The showing under 37 CFR 1.195 is not deemed sufficient to justify entry of the exhibits. Appellants state that much of the information was available prior to the Appeal but was nonetheless withheld until a greater body of exhibits could be filed. As the material all relates to commercial acceptance and success any additional material not available at the time of appeal would merely appear to have been cumulative to that available at the time of appeal and would not justify the delay in prosecution caused by a first time consideration of such material being undertaken in the examiner's answer.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

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Appellant's brief includes a statement that claims 1-13 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

4,431,193	Nesbitt	2/14/84
5,068,151	Nakamura	11/26/91

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nesbitt in view of Nakamura. This rejection is set forth in prior Office action, Paper No. 2.

(11) *Response to Argument*

Appellant's first argument, page 6 of brief, is that Nakamura does not suggest the use of hard, high acid ionomer resins to formulate the inner cover layer. This argument misses the entire point of the rejection. The primary reference Nesbitt teaches that to manufacture the ball one should use a relatively hard material. Although Nesbitt only suggests one particular material, it would have been obvious to one of ordinary skill in the art that other known hard materials used in the art would have been suitable for Nesbitt's purpose. Nakamura teaches

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that one hard material which is known in the art is a high acid ionomer including "10 to 20% by weight of an alpha, beta-unsaturated carboxylic acid". Given that such a hard material is known in the art, and that Nesbitt desires a hard material, it would have been obvious to one of ordinary skill in the art to have utilized such a material to provide the effects desired by Nesbitt. This is the context in which the secondary reference Nakamura must be viewed. The examiner has not cited Nakamura to show that such materials have heretofore been used in an inner cover layer, but rather to show that such materials are known in the art and are of the type of material desired by Nesbitt in manufacturing his ball.

Further addressing appellant's arguments, it should be noted that Nakamura does not "briefly suggest" the claimed material. The claimed material is recited throughout the Nakamura patent. See the Abstract, Summary of the Invention, Detailed Description of the Invention, and Claims 1 and 5.

As to the "commercial availability" in the U.S., appellant has offered no evidence to back up his argument. Moreover, there is no requirement that a material disclosed by a prior art reference be "commercially available."

Regarding appellant's argument C.1., which begins on page 8, each point advanced by appellant has been previously addressed by the examiner above.

Concerning appellant's C.2. argument, Nesbitt discloses that the thicknesses of the inner and outer layers may be varied as desired, (Col. 2, line 65 - Col. 3, line 25) and with regard to claim 4 discloses the specifically claimed dimensions. Regarding claim 5, it is the

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examiner's opinion that absent a showing of criticality/unexpected results, the claimed dimensions would have been obvious to one of ordinary skill in the art seeking to obtain a particular flight effect from the golf ball.

With regard to appellant's C.3. argument, Nesbitt teaches that the outer layer may be formed from a suitable relatively soft material. As the appellant discloses in his specification, (see page 34, first paragraph), suitable soft materials are known in the art. In view of Nesbitt's disclosure it would have been obvious to one of ordinary skill in the art to have utilized such a known material to form the outer layer. This was pointed out to the appellant in the last 4 lines of the 4/8/94 office action. Regarding appellant's C.4. argument, the same analysis applies with regard to appellant's specification at page 34, last paragraph through page 35 first paragraph.

Concerning claims 12 and 13, the appellant has again cited known materials suitable for Nesbitt's purpose. Based on Nesbitt's teaching, these are exactly the materials which the ordinarily skilled artisan would seek to use in manufacturing the golf ball. Therefore appellant's choice of such cannot be considered unobvious. Regarding the particularly claimed modulus, such would obviously have been varied by the ordinarily skilled artisan within the claimed range to obtain a particular flight characteristic. Absent some unexpected result the claimed modulus cannot be seen as unobvious.

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Appellant's argument "D." beginning on page 12 of the brief has not been addressed as the evidence in support thereof has not been submitted in a timely fashion, and therefore has not been entered as noted above.

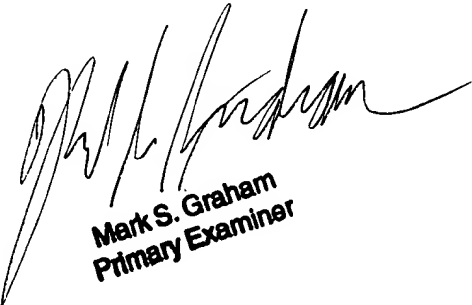
In conclusion, it is the examiner's opinion that the appellant has taken a known ball, (Nesbitt) and merely used known materials suitable for Nesbitt's purpose to manufacture the ball. This is completely in accordance with what Nesbitt teaches. That appellant has chosen materials not available at the time of the Nesbitt patent, but which were known prior to the instant application, and clearly among the type contemplated by Nesbitt's invention, is not considered unobvious.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Mark S. Graham

December 21, 1998



Mark S. Graham
Primary Examiner